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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,804	03/30/2001	Bill Kitchen	3350-05F	6580

7590 09/13/2005
Antonelli, Terry, Stout & Kraus, LLP
Suite 1800
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Arlington, VA 22209

EXAMINER

KAZIMI, HANI M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,804

Applicant(s)

KITCHEN ET AL.

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 34,36-38,40-43,45-47 and 49-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 34,36-38,40-43,45-47 and 49-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on March 1, 2005. The rejections cited are as stated below:

Response to Applicant's amendment

2. Applicants' amendment filed on March 1, 2005 have been fully considered, and discussed in the next section below or within the following rejections are not deemed to be persuasive. Applicants' request for allowance is respectfully denied.

Specification

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118

(Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The Applicant has added claims 52-55 to include the limitation “--- wherein each biller category is *not* associated with a status of a bill being one of paid and unpaid---”. However, the specification does not provide an enabling disclosure to support the claimed step of “wherein each biller category is *not* associated with a status of a bill being one of paid and unpaid”. As discussed in the previous office action, Applicant’s disclosure page 28, second paragraph, states “Fig. 9B depicts screen 930 which can be transmitted from the CF station 140 to present summary bill related information at the payer station 120a-12d in a categorized manner. As shown, by clicking on indicator 935, categories of biller are changed in block 940. For example, in screen 930 the category been set to *unpaid bills* and accordingly, a summary of all *unpaid bills* appears on the payer display 460. Other categories could be, for example, utility bills, *paid bills*, questioned bills, credit card bills or any other category which may be desirable under the particular circumstances”.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 52-55 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 52-55 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. For further examination purposes, the Examiner interprets the claimed limitations in light of 35 U.S.C. § 112, first paragraph rejection.

Claim Rejections – 35 U.S.C. 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

8. Claims 34, 36-38, 40-43, 45-47, and 49-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al. US Patent No. 6,128,603 (hereinafter "Dent") in

view of Hogan US Patent No. 5,699,528 as discussed in paragraph 4 of the previous office action mailed on December 1, 2004. Further:

Dent teaches that "wherein each biller category is at least one of i) a biller category associated with a type of good or service provided by a biller, and ii) a biller category defined by a payor" (figs. 5-9, column 7, line 35 thru column 8, line 2, and column 10, line 60 thru column 11, line 42).

Response to Arguments

9. In the remarks, the Applicant argues in substance that;

a) "Dent does not disclose a user choosing to view those bills that belong to a biller category associated with a type of good or service provided by a biller, nor does Dent disclose a user choosing to view those bills belonging to a payor defined biller category, as required by independent claims 34 and 43. Dent only discloses a user choosing to view those bills that are either unpaid or "paid today," i.e., a user choosing to view those bills having a status of paid or unpaid. Thus, Dent does not disclose a biller category that is not associated with a status of a bill that is one of paid and unpaid, as required by independent claim 52. Furthermore, Hogan does not disclose the biller categories as required by independent claims 34, 43, and 52. Rather, as discussed in the prior Request For Reconsideration, Hogan, at best, teaches bill categories".

b) Dent does not disclose that the plurality of biller categories include a category corresponding to at least one of a credit card service and a utility service, at least one of the plurality of billers be associated with more than one biller category, and

that the payer request to view those bills associated with one of a plurality of bill categories, the plurality of bill categories including a disputed bill category..

In response to a);

Claims 34 and 43, recite, "wherein each biller category is *at least one of* i) a biller category associated with a type of good or service provided by a biller, and ii) a biller category defined by a payor". Dent has to teach at least one of the two in order to meet the claimed limitations. Furthermore, the term *associated with* is a very broad term, a biller category can be "paid bills" or "unpaid bills" (as discussed in Applicant's specification on page 28, second paragraph), if the user clicks on (i.e. "unpaid bills", the bill has to be *associated with* a type of good or service provided by a biller.

Applicant's arguments with respect to claims 52-55 that "Dent does not disclose a biller category that is not associated with a status of a bill that is one of paid and unpaid, as required by independent claim 52" have been considered but are moot in view of the new ground(s) of rejection under 35 U.S.C. § 112, first paragraph rejection above.

In response to Applicant argument with respect to the Hogan reference that it does not disclose the biller categories. The Examiner did not rely on the Hogan reference to teach the biller categories as required by independent claims 34, 43, and 52. The Examiner relied on Hogan to teach a system and method for bill delivery and payment over a communications network wherein a user submits a request via a network to receive bills, and receives and pays bills via the network (figs. 2-4, and column 5, line 1 thru column 6, line 30).

In response to b);

The term “corresponding” to *at least one* of a credit card service is a very broad term. The Examiner interprets the term “corresponding” broader than intended because in Dent, the plurality of biller categories can be “unpaid bills” and when clicking on unpaid bills it does “correspond” to at least one a credit card service (Dent, fig. 5, 4th line, “AMEX” American Express) and a utility service (Dent, fig. 5, shows all the utility services, e.g. “GPU” 8th line, for electric). In response to the argument that Dent does not disclose “.. at least one of the plurality of billers be associated with more than one biller category”. Dent, fig. 5, shows only a few samples of credit card services and utility services, consider the scenario where a payer has a VISA card by Citibank under “unpaid bills” and a MASTER card by the same biller Citibank under “paid bills”, which reads on the claimed limitation where one of the plurality of billers (Citibank) be associated with more than one biller category (unpaid bills and paid bills). Similar to the argument “.. that the payer request to view those bills associated with one of a plurality of bill categories, the plurality of bill categories including a disputed bill category”. Again the term *associated with* is a very broad term, view those bills “*associated with*” a plurality of bill categories (“unpaid bills and paid bills”) and these categories include a disputed bill category (figs. 8 and 9 under the CROWN icon). Similarly, claims 41, 42, 50 and 51 require a payor request to view those of the stored plurality of bills that are both unpaid or paid and “*associated with*” one of the plurality of biller categories, and a transmission responsive thereto.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

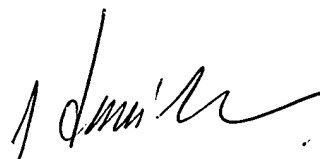
' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER
Art Unit 3624

August 29, 2005